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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,778	03/02/2007	Jose Ruiz Caston	7572-74819-01	6010
24197 7590 10/10/2008 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204				
EXAMINER MOSHER, MARY				
ART UNIT		PAPER NUMBER		
1648				
MAIL DATE		DELIVERY MODE		
10/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/576,778

**Applicant(s)**

CASTON ET AL.

**Examiner**

Mary E. Mosher, Ph.D.

**Art Unit**

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-20, 22 and 23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10, 12-20, 22 and 23 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 21 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date 3/9/07.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 requires yeast of *Saccharomyces* genus. *S. pombe* (more correctly termed *Sc. pombe*) is in the *Schizosaccharomyces* genus. Therefore claim 10 encompasses subject matter excluded from parent claim 9.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-8, 12, 13, 15-20, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitcovski et al (Vaccine 21:4736-4743, 2003) (cited in IDS). Pitcovski teaches cloning a 1372 bp fragment of IBDV VP2 into a yeast expression vector. See pages 4737 and 4739. This 1372 fragment apparently encodes VP2 amino acids 1-457 (1372 divided by 3 = 457.333). Pitcovski expresses the sequence in *P. pastoris*, and recovers the protein from the supernatant of cells disrupted by glass beads. This is the essentially same procedure followed by applicants on specification page 15. Although the reference does not state that empty capsids were assembled,

there is good reason to believe that assembled capsids inherently formed, since the reference followed essentially the same steps that were shown in the specification to result in empty capsids. Therefore, the reference inherently, if not explicitly, teaches products and methods that meet the claim limitations.

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitcovski et al (Vaccine 21:4736-4743, 2003) (cited in IDS). These claims differ from Pitcovski in that the reference teaches a protein with 457 amino acids instead of the claimed 456 amino acids. However, the difference of a single amino acid is seen as an obvious variation, absent unexpected results. Therefore, the invention as a whole is prima facie obvious.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitcovski et al as applied to claims 7-8 above, and further in view of Jagadish et al (Gene 108: 275-279, 1991). These claims differ from Pitcovski in that they are drawn to

transformed *S. cerevisiae* or *Sc. pombe* yeast, while Pitcovski used transformed *P. pastoris* yeast. However, Jagadish teaches successful expression of IBDV VP2 in *S. cerevisiae*. It would have been within the ordinary skill of the art to use a conventional alternative species of yeast for expression of the sequence of Pitcovski, with reasonable expectation of success. Therefore, the claimed yeast cells are prima facie obvious, absent unexpected results.

Caston et al (Journal of Virology 75:10815-10828, 2001) (cited in IDS) is cited as of interest, in teaching that both 1-516 and 1-456 VP2 spontaneously assemble into particles in insect cells. Da Costa et al (Journal of Virology 76:2393-2402, 2002) (cited in IDS) is cited as of interest in teaching that natural processing of virion VP2 cleaves off C-terminal portions between residues 442 and 516.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is 571-272-0906. The examiner can normally be reached on varying dates and times; please leave a message.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campbell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary E Mosher, Ph.D./  
Primary Examiner, Art Unit 1648

10/8/08